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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/811,612

Applicant(s)

MILLER, BRAD A.

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a formulation for preservation of film, classified in class 430, subclass 523.
- II. Claims 10-17, drawn to a method of preserving a film and the film, classified in class 427, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used as fuel source.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their

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recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Dwayne L. Mason on 1/5/07 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 10-17 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

6. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the

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above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1 and 5 are deemed to contain new matter in that applicant's specification as originally filed does not clearly support a formulation for preservation of film that comprises only (a) an alkyl benzene and (b) an aliphatic petroleum distillate. Applicant's specification as originally filed clearly disclosed that the aliphatic petroleum distillate was only one constituent part of a three part mixture of the "aliphatic hydrocarbon portion" which comprised aliphatic petroleum naphtha, aliphatic petroleum distillate and petroleum base oil, see page 3,

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line 19 to page 4, line 3 of the specification. Please notice that claim 6 has NOT been rejected here.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-5 and 9 are indefinite in regards to the evaporation rate. Under what conditions is the evaporation taking place (e.g. temperature, pressure etc.)?

Furthermore is the listed evaporation rate the time needed for total evaporation of the formulation or just part of the formulation?

Claim 6 is indefinite because there is no antecedent basis for the phrase "said hydrocarbon".

The other claims are being rejected here because they are dependent on rejected base claims.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,712,994.

Although the conflicting claims are not identical, they are not patentably distinct from each other because there is massive overlap in the claimed subject matter.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Feighner et al. U.S. Patent Number 3,316,294 or Forsberg U.S. Patent Number 4,322,478 or Forsberg U.S. Patent Number Re. 32,235 or Krenowicz et al. U.S. Patent Number 3,812,035.

Feighner et al teach detergent alkylate benzenes and the sulfonate derivative. Applicant's claims are deemed to be anticipated over Examples III and IV. Please note that the non-chlorinated normal paraffins are deemed to read on applicant's aliphatic

petroleum distillates since they are derived from the well known process of fractional cracking/distillation.

Forsberg teaches thixotropic magnesium-containing complexes are prepared by heating a mixture of magnesium hydroxide, magnesium oxide, hydrated magnesium oxide or a magnesium alkoxide; a sulfonic acid, a pentavalent phosphorus acid, a mixture thereof with a carboxylic acid, or an ester or salt of any of these; water (optional under certain conditions); and an organic solubilizing agent (which may be liquid or solid at ambient temperature) for the acid or ester. The amount of magnesium is such as to provide a basic composition. The resulting complexes may be obtained in liquid or solid form, and are useful as additives for lubricants and fuels and as protective coating compositions for metal surfaces (such as automotive undercoats and frame coatings), see abstract. Applicant's claims are deemed to be anticipated over the solvent mixtures set forth in column 7, lines 25-28 and Example 5. Please note that Stoddard solvent is a well known aliphatic petroleum distillates.

Forsberg teaches magnesium-containing complexes are prepared by heating a mixture of magnesium hydroxide, magnesium oxide, hydrated magnesium oxide or a magnesium alkoxide; a sulfonic acid, a pentavalent phosphorus acid, a mixture thereof with a carboxylic acid, or an ester or salt of any of these; water (optional under certain conditions); and an organic solubilizing agent (which may be liquid or solid at ambient temperature) for the acid or ester. The amount of magnesium is such as to provide a basic composition. The resulting complexes may be obtained in liquid or solid form, and are useful as additives for lubricants and fuels and as protective coating compositions

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for metal surfaces (such as automotive undercoats and frame coatings), see abstract.

Applicant's claims are deemed to be anticipated over column 6, lines 45-47 and

Example 5. Also see column 5, line 54 to column 6, line 54.

Krenowicz et al. teach lubricating oil compositions comprising certain synthetic alkaryl hydrocarbon lubricants and mineral lubricating oils have improved properties, such as oxidation stability and pour point. A typical synthetic alkaryl hydrocarbon lubricant contains from 61 to 92 weight percent di-n-alkylbenzenes and 5 to 30 weight percent tri-alkyl-substituted tetrahydronaphthalenes. Because of their low pour points, the lubricating oil compositions are useful in certain specific low temperature (i.e., Arctic) operations. In addition, the lubricating oil compositions are useful in preparing lubricating greases for low temperature operations, see abstract. Applicant's claims are anticipated over the many examples.

16. Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wilson U.S. Patent Number 6,239,097.

Wilson teaches a cleaning formulation containing an alkyl aromatic useful as a solvent. The alkyl aromatic generally is a mono-, di-, or tri-alkylated aromatic. This cleaning composition has excellent balance between solvency, flash point and odor and is useful in a variety of cleaning situations, see abstract. Applicant's claims are deemed to be anticipated over Example 1. Please note that the pentene component reads on applicant's aliphatic petroleum distillates since they are derived from the well known process of fractional cracking/distillation.

17. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Feighner et al. U.S. Patent Number 3,316,294 or Forsberg U.S. Patent Number 4,322,478 or Forsberg U.S. Patent Number Re. 32,235 or Wilson U.S. Patent Number 6,239,097.

18. All patents have been described above and are deemed to anticipate applicant's claimed invention over the disclosure of each patent. In the alternative, the patents may be said to differ from applicant's claimed invention in that there does not seem to be a direct teaching (i.e. by way of an example) to a formulation that actually comprises aliphatic petroleum naphtha, aliphatic petroleum distillate and petroleum base oil. It would have been obvious to one having ordinary skill in the art to use the the disclosure of each patent as motivation to actually add aliphatic petroleum naphtha, aliphatic petroleum distillate and petroleum base oil to the taught formulation since such comes within the broad disclosure of each patent.

19. Claims 2-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krenowicz et al. U.S. Patent number 3,812,035 optionally in view of Chen et al. U.S. Patent Number 5,105,038.

Krenowicz et al has been described above and differs from applicant's claimed invention in that there does not seem to be a direct teaching (i.e. by way of an example)

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to a formulation that meets all of applicant's claimed limitation in terms of boiling point range, specific gravity, evaporation rate etc.

Chen et al teach synthetic lubricant blends exhibiting superior lubricant properties such as high viscosity index, including mixtures of oligomeric products of shape selective catalysis with other lubricants, such as high viscosity index poly- α -(α -) olefins lubricant basestock, conventional poly(α -olefin) and/or other liquid lubricant basestock material. Preferred lubricant mixtures comprise hydrogenated components: a) a low viscosity C₂₀-C₆₀ lubricant range liquid comprising substantially linear hydrocarbon moieties prepared by shape selective catalysis of lower olefin with medium pore acid zeolite catalyst to provide substantially linear liquid olefinic intermediates or C₂₀⁺ lubricants, said lubricant range liquid having a kinematic viscosity of about 2-10 cS at 100.degree. C.; and b) at least one poly(α -olefin) having viscosity greater than 20 cS and viscosity index improvement properties.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of the patent alone as strong motivation to make formulation that meet all of applicant's claimed parameters. Note only does the patent broadly disclosed such parameters, but such parameters are easily optimized by the ordinary artisan. Optional Krenowicz et al can be taken in view of Chen et al for their disclosure of aliphatic petroleum distillate and aliphatic hydrocarbon in general as motivation to add use aliphatic hydrocarbons to the formulation disclosed by Krenowicz et al..

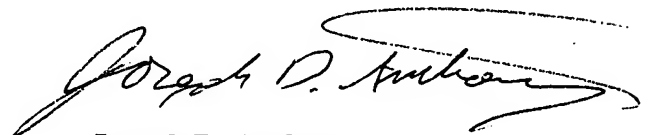
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Prior-Art Cited But Not Applied

20. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714**

1/8/07